

## REMARKS

Claims 3, 10, 14-15, 17, 22-27, and 32 are amended herein. In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has objected to the disclosure because of an informal error on page 4, line 5 of the Specification (“a operator system” should be “an operator system”). The relevant paragraph, paragraph [0015], is amended herein to correct this typographical error. Accordingly, Applicants respectfully request that this objection be withdrawn.

In addition, the Office has objected to claims 3, 10, and 17 because the phrase “at least one criteria” should be “at least one criterion” because “criterion” is singular, and “criteria” plural. Claims 3, 10, and 17 are amended herein in conformance with the Office’s suggestion. Accordingly, Applicants respectfully request that this objection be withdrawn.

Furthermore, the Office has objected to claim 14 because claim 14 recites a dependency on itself. Claim 14 is amended herein to recite its dependency on claim 13. Accordingly, Applicants respectfully request that this objection be withdrawn.

Similarly, the Office has objected to claims 23, 24, and 25 as reciting “The method as set forth in claim 21,” but claim 21 is a system claim. Claims 23-25 are amended herein to recite a dependency on claim 22, which is a method claim. Accordingly, Applicants respectfully request that this objection be withdrawn.

Finally, the Office has objected to claim 26 because claim 26 recites “the retailer that sold the device,” which lacks proper antecedent basis in claim 24. Claim 26 is amended herein to recite a dependency on claim 25, which recites identifying a retailer that sold the device. Accordingly, Applicants respectfully request that this objection be withdrawn.

The Office has rejected claims 22-26 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office asserts that the recited method for ordering a consumable may be, in a sense, useful, but is not concrete or tangible, and recites no steps that involve manipulating technology. Claim 22 is amended herein to recite “submitting an order with the device” which is clearly a manipulation of technology and patentable subject matter under 35 U.S.C. § 101. As claims 22-26 depend from and include the features of

claim 22, they also recite patentable subject matter under 35 U.S.C. § 101. Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

In addition, the Office has rejected claims 22-24 and 32-34 under 35 U.S.C. § 102(e) as being anticipated by, and claims 1-6, 8-13, 15-20, 24, 27-29, and 34 under 35 U.S.C. § 103(a) as being obvious in view of, U.S. Patent 6,629,134 to Hayward et al. (Hayward). Similarly, the Office has rejected claims 25, 30, and 35 under 35 U.S.C. § 103(a) in view of Hayward and official notice.

Furthermore, the Office has rejected claims 1-3 and 15-17 under 35 U.S.C. § 102(e) as being anticipated by, and claims 8-10 under 35 U.S.C. § 103(a) as being obvious in view of, U.S. Patent Application Publication 2002/0072998 to Haines et al. (Haines). In addition, the Office has rejected claims 5-6, 12-13, 22-24, 27-29, and 32-34 under 35 U.S.C. § 103(a) as being obvious in view of Haines in further view of U.S. Patent No. 6,029,141 to Bezos (Bezos). Similarly, the Office has rejected claims 4 and 11 under 35 U.S.C. § 103(a) in view of Haines and official notice. Finally, the Office has rejected claims 15-20, 25, 30, and 35 under 35 U.S.C. § 103(a) in view of Haines, Bezos, and official notice.

However, none of Hayward, Haines, or Bezos, taken alone or in combination, discloses or suggests a method including the step of “submitting with the device the order for the at least one of the consumable to a supplier” as recited in claim 1, a computer readable medium having instructions for “submitting with the device the order for the at least one of the consumable to a supplier” as recited in claim 8, a system comprising an “ordering system with the device that submits the order for the at least one of the consumables to a supplier” as recited in claim 15, a method including the step of “submitting an order with the device for the at least one consumable for the device” as recited in claim 22, a computer readable medium having instructions for “submitting an order with the device for the at least one consumable for the device” as recited in claim 27, or a system for “an ordering system that submits an order with the device for the at least one consumable for the device” as recited by claim 32.

Instead, Hayward discloses, as is shown in Fig. 2, a system wherein a computer is located between a device and the supplier on a network. When ordering a new consumable for the device, a browser is opened on the computer, and a purchase order page is displayed

to the user. After the user fills out the purchase order screen, the order is sent directly to the supplier's server either via the browser, or via e-mail. Portions of the purchase order page, such as the user's personal information, may be automatically entered based on information stored on the computer. (Col 8, lines 5-37). It would not have been obvious to a person of ordinary skill in the art to place an order for a consumable with the device rather than placing the order via a browser on a computer having a direct connection to the supplier as is taught by Hayward.

Haines discloses, as is shown in Fig. 3 and as described in para. [0054], a system wherein a maintainer can detect a signal from a device via a computer indicating a consumable's status, such as "TONER LOW". In particular, the maintainer retrieves the status of the consumables of the device by submitting a request to a computer, which then obtains the information via a network. (Para. [0064]). Also, the device may send a message to a computer indicating that a consumable is needed, and the message may be transferred to the maintainer via a user interface on the computer. (Para. [0055]). The maintainer then may take actions provide "NEW TONER" to the device. For example, the maintainer may retrieve the consumable from an inventory and provide it to the device. As with Hayward, it would not have been obvious to a person of ordinary skill in the art to place an order for a consumable with the device rather than placing the order via a maintainer in communication with a supplier as is taught by Haines.

Bezos is applied for its disclosure of the use of cookies to identify a customer when that customer places an order. The process of using cookies may include retrieving cookies from the customer's computer using a web server, and using the information in the cookies to e customer. (Col. 8, lines 17-26). Bezos does not teach or render obvious the novel feature of the claimed invention.

To the contrary, the claims recite systems, methods, and media wherein an order for consumables is submitted with the device. As is shown in Fig. 1 of the present application, device 11 includes a communication system that is connected to supplier processing system 26. When a new consumable, such as an ink cartridge, is needed for use in a device, such as a printer, a customer may place an order using a graphic user interface of the device. The order is transmitted to the supplier processing system over a network connection via the device, rather than placing the order with a computer with a network connection. Thus, the

claimed invention provides advantages over the teachings of the prior art. For the customer is able to save time by being able to reorder consumables directly from the device. In addition, the use of the device to place the order helps to direct the business from the sale of the consumables back to a specific retailer, such as the original retailer of the device.

With respect to the assertions of official notice stated above, the Office asserts via official notice that it is well known to maintain and retrieve records of which dealer sold a device, and that it is well known to confirm an order before submitting it. If the official notice is beyond the scope of the above, Applicants respectfully request additional clarification from the Office.

Based on the amendments and remarks above, Applicants respectfully submit that none of Hayward, Haines, or Bezos teach or render obvious the novel features recited in independent claims 1, 8, 15, 22, 27, or 32. Claims 2-6, 9-13, 16-20, 23-26, 28-30, and 33-35 are also allowable on their own merits, in addition to their allowability by virtue of their dependencies on claims 1, 8, 15, 22, 27, or 32. Accordingly, Applicants respectfully request that the rejections of claims 1-6, 8-13, 15-20, 22-30, and 32-35 under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103(a) in view of Hayward, Haines, or Bezos, applied alone or in combination, be reconsidered and withdrawn.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,



---

Marc S. Kaufman  
Registration No. 35,212

Date: August 8, 2005

NIXON PEABODY LLP  
c/o Gunnar G. Leinberg, Reg. No. 35,584  
Clinton Square, P.O. Box 31051  
Rochester, New York 14603-1051  
Telephone: (585) 263-1014  
Facsimile: (585) 263-1600